

Claims 1-13 are all the claims pending in the application. The Examiner has indicated that claims 8 and 9 contain allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**I. Preliminary Matters**

Applicant respectfully requests that the Examiner approve the drawings filed December 21, 2000.

In addition, Applicant respectfully submits that the finality of the present Office Action is improper. On page 6 of the present Office Action, the Examiner states that finality is necessitated by Applicant's amendment. However, claims 2 and 7-12 were merely amended to address the Examiner's rejection of the claims under 35 U.S.C. § 112, second paragraph in the February 3, 2004 Office Action.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should **not** be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP Section 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element. MPEP 706.07(a).

Applicant merely amended claims 2 and 7-12 in order to address the Examiner's § 112 rejection, therefore the amendments to claims should have reasonably been expected by the Examiner. Furthermore, no new matter was added to the claims. Consequently, Applicant respectfully requests that the finality of the present Office Action be withdrawn.

## **II. Claim Rejections under 35 U.S.C. § 102**

Claims 1-7 and 10-13 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Zicker et al. (U.S. Patent No. 5,794,141). Applicant submits the following in traversal of the rejection.

Zicker addresses the problems associated with activating a cordless base station. In a first phase of activation, cordless base station programming data are transferred from a customer activation system to a handset. During a second phase of activation, the cordless base station programming data are transferred from the handset to a cordless base station. See Abstract.

### **Claim 1**

Claim 1 describes a radiotelephone terminal unit for a subscriber. The radiotelephone terminal unit comprises a portable terminal and a radiotelephone terminal. The Examiner cites cordless base station 22 for teaching the radiotelephone terminal unit of claim 1. The Examiner cites handset 18 for teaching the portable terminal of claim 1. However, it is apparent upon viewing Fig. 1 of Zicker, that although cordless base station 22 (radiotelephone terminal unit as cited by the Examiner) interacts with handset 18, base station 22 does not comprise handset 18. Therefore, a radiotelephone terminal unit does not comprises a portable terminal as recited in claim 1.

The Examiner then asserts that base station 22 teaches a radiotelephone terminal. However, a base station is not a radiotelephone terminal, as claimed. This would be apparent to one of ordinary skill in the art.

Moreover, at no point would a user have simultaneous access to both a handset 18 and the base station 22. At most a user has access to handset 18 which is used to engage in cellular or cordless communications. See col. 7, lines 58-60. Base station 22 is located in an area separate from the handset 18, for example, a few hundred feet. Col. 1, lines 65-67. There is no indication that a user can access the base station 22. In particular, there is no need for user access to base station 22 because any operations desired by the user are performed through handset 18.

For at least these reasons, claim 1 and its dependent claims should be deemed patentable. Since claim 7 describes similar subject matter, claim 7 and its dependent claims should be deemed patentable for the same reasons.

#### **Claim 2**

The Examiner asserts that Zicker teaches that a portable terminal and a radiotelephone terminal are equipped with one of a man-machine interface and software means which are at least partly complementary, as recited in claim 2. However, there is no indication that the base station 22 is equipped with a man-machine interface. As indicated above, there is no need for a man-machine interface in base station 22 because a user interacts with a handset 18 and does not directly interact with base station 22. For at least this reason, claim 2 should be deemed patentable.

**Claim 3**

Claim 3 recites that the portable terminal and the radiotelephone terminal include transceiver means. However, the Examiner has not established where a transceiver means and software means are disclosed in the handset 18 or base station 22 of Zicker.

Claim 3 further recites that transceiver means and software means enable the portable terminal and the radiotelephone terminal to communicate by radio with a relay transceiver station of a communication network via a respective different radiotelephone link during a call involving the portable terminal. However, there is no indication that handset 18 and base station 22 communicate with central telephone office 24 (relay transceiver station as cited by the Examiner). It is apparent upon viewing Fig. 1, that only base 22 is capable of communicating with central telephone office 24. Furthermore, since only base station 22 is capable of communicating with central telephone office 24, there would not appear to be a need for a separate link.

For at least these reasons, claim 3 should be deemed patentable.

**III. Conclusion**


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116  
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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